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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,290	11/21/2000	Daniel C. Castle	10002934-1	2957

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Intellectual Property Administration  
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EXAMINER
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RAYYAN, SUSAN F

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 04/29/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/718,290

Applicant(s)

CASTLE, DANIEL C.

Examiner

Susan F. Rayyan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,13-15,17-19,22-24,26-28,31-33,35-37,40-42,44-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,13-15,17-19,22-24,26-28,31-33,35-37,40-42,44-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election without traverse of claims 10-49 in Paper No. 4 is acknowledged.
2. Claims 1-9 are withdrawn from further consideration (paper no. 4).
3. Claims 11-12, 16, 20-21, 25, 29-30, 34,38-39, and 43 have been canceled (paper no. 4).
4. Claims 10, 13-15,17-19,22-24,26-28,31-33,35-37,40-42 and 44-49 remain pending in the application.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 10, 13-15,17-19,22-24,26-28,31-33,35-37,40-42 and 44-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 10,19,28,37 the limitations "transmitting at least a portion of the reader profile information for display to the reader " and "the reader profile information includes one or more type of denied data that is transmitted to the reader for display" are contradictory. (The limitation "transmitting at least a portion of the reader profile information for display to the reader" is interpreted as transmitting some of the profile (which could be any type of profile data). The limitation "the reader profile information

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includes one or more type of denied data that is transmitted to the reader for display" is interpreted as transmitting the entire reader profile which contains denied data.)

In addition, the Examiner did not find "denied data" displayed with the content. In the specification ((p. 11, lines 19, bridging to p. 12, line 2) the Examiner found a teaching for displaying "pertinent profile information" with the content, the pertinent profile information being provided so that the reader knows why he is receiving the content. The reader would not receive content associated with the denied data. The pertinent profile information would therefore not contain the denied data.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 10, 17-19,26-28,35-37,44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) in view of Ellis et al (Pub. No.: US 2003/0020744).**

**As per independent claim 10,37 Dasan teaches:**

"A document delivery system for delivery of documents to a reader via a network" at Summary;

"a knowledge module containing profile information, including at least reader

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“profile information” at col.5, lines 59-64 and col. 6, line 61, bridging to, col.7, line 21, fig. 4;

“an edit module containing first content” at col. 8, lines 29-39;

“a transmission module for transmitting the first content”... “to a reader for display based upon the profile information” at col. 7, lines 52-52 and col. 8, lines 26-40;

“transmitting at least a portion of the reader profile information for display to the reader” and “that is transmitted to the reader for display” at col. 8, lines 26-32 and fig.11.

Dasan does not explicitly teach “second content” however Hoyle does teach “second content” at col.16, lines 28-41 and fig. 1. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

Dasan and Hoyle do not explicitly teach “profile information includes one or more types of denied data” however Ellis does teach this limitation (illegal) at fig. 13E and p. 9, paragraph 94. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to customize the viewing experience (p.1, paragraph 8, line 4-5).

**As per claim 17, 26,35,44 same as claim arguments above and Dasan teaches:**

“wherein the transmission module further transmits an interface usable by the reader to modify the reader profile information” at fig. 8.

**As per claim 18,27,36,45 same a claim arguments above and Dasan:**

“wherein the interface is a universal resource locator for a page usable by the reader to modify the reader profile information” at fig.8.

**As per independent claim 19 Dasan teaches:**

“a method of delivering informational content to a reader” at Summary;

“receiving profile information, including at least reader profile information

identifying content preferences for the reader” at col.5, line 65, bridging to, col. 6, line10;

“receiving first content” at col. 6, lines 11-18;

“transmitting to a reader the first content” ... “based on the profile information, and at least a portion of the reader profile information” at col. 7, lines 52-54 and col. 8, lines 26-40;

“ that is transmitted to the reader for display” at col. 8, lines 26-32 and fig.11.

Dasan does not explicitly teach “receiving second content” however Hoyle does teach this limitation at col. 16, lines 28-41 and fig. 1. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

Dasan and Hoyle do not explicitly teach “profile information includes one or more types of denied data” however Ellis does teach this limitation (illegal) at fig. 13E and p. 9, paragraph 94. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to customize the viewing experience (p.1, paragraph 8, line 4-5).

**As per independent claim 28 Dasan teaches:**

“a method of receiving content to read” at Summary;

“receiving a display of first content; at col. 6, lines 11-18;

“receiving a display of profile information, including at least reader profile information, related to the first or second content” at col. 7, lines 52-54 and col.8, lines 26-40;

“ that is transmitted to the reader for display” at col. 8, lines 26-32 and fig.11.

Dasan does not explicitly teach “ receiving a display of second content” however Hoyle does teach this limitation at col. 16, lines 28-41. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col. 16, lines 28-29, Abstract).

Dasan and Hoyle do not explicitly teach “profile information includes one or more types of denied data” however Ellis does teach this limitation (illegal) at fig. 13E and p. 9, paragraph 94. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to customize the viewing experience (p.1, paragraph 8, line 4-5).

**As per claim 46 same as claim arguments above and Dasan:**

“wherein said edit means is comprised of a computer” at figs. 1-4.

**As per claim 47 same as claim arguments above and Dasan teaches:**

“wherein said knowledge storage means is comprised of a computer” at figs. 1-4.

**As per claim 48** same as claim arguments above and Dasan teaches:

“wherein said transmission means is comprised of a computer” at figs. 1-4.

**As per claim 49** same as claim argument above and Dasan teaches:

“wherein said transmission means is comprised of a data network” at figs. 1-4.

**9. Claims 13-14,22-23,31-32,40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) and Ellis et al (Pub. No.: US 2003/0020744) in view of Guyot et al. (US 6,119,098)**

**As per claim 13-14,22-23,31-32,40-41** same as claim arguments above and

Dasan, Hoyle and Ellis do not explicitly teach “wherein the profile information includes a advertiser profile information corresponding to the second content” and “wherein the advertiser profile information includes one or more types of information selected from the group consisting of: global advertiser information and specific advertiser profile information” however Guyot teaches this limitation at col. 3, line 66, bridging to col. 4, line 14. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to identify the advertisers that provide the advertisement to the subscribers (Guyot: col.3, line 66, bridging to, col.4, line 34).

**10. Claims 15,24,33,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) and Ellis et al (Pub. No.: US 2003/0020744) in view of Headerick et al. (US 6557006).**

**As per claim 15,24,33,42** same as claim arguments above and Dasan teaches

“voluntary information” at fig.8. Dasan, Hoyle, and Ellis do not explicitly teach “wherein



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the reader profile information includes one or more types of information selected from the group consisting of: behavior profile information” however Headerick does teach voluntary profile information and behavior profile information at col.8, lines 21-27. Thus it would have been obvious to one of ordinarily skilled in the art at the time of the invention to combine the cited references to track demographic information (Headerick: col.8, line 19).

### ***Response to Arguments***

11. Applicant's arguments filed on April 1, 2004 have been fully considered but they are not persuasive.

12. In response to Applicant's argument that Dasan, Hoyle and Ellis et al do not teach “that is transmitted to the reader for display” Examiner respectfully disagrees. Dasan teaches this limitation at col. 8, lines 26-32 and fig.11.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case:

**Regarding claims 10,17-19,26-28,35-37,44-49,**

Dasan does not explicitly teach “second content” however Hoyle

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does teach "second content" at col.16, lines 28-41 and fig. 1. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

Dasan and Hoyle do not explicitly teach "profile information includes one or more types of denied data" however Ellis does teach this limitation (illegal) at fig. 13E and p. 9, paragraph 94. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to customize the viewing experience (p.1, paragraph 8, line 4-5).

**Regarding claims 13-14,22-23,31-32,40-41,**

Dasan, Hoyle and Ellis do not explicitly teach "wherein the profile information includes a advertiser profile information corresponding to the second content" and "wherein the advertiser profile information includes one or more types of information selected from the group consisting of: global advertiser information and specific advertiser profile information" however Guyot teaches this limitation at col. 3, line 66, bridging to col. 4, line 14. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to identify the advertisers that provide the advertisement to the subscribers (Guyot: col.3, line 66, bridging to, col.4, line 34).

**Regarding claims 15,24,33,42,**

Dasan, Hoyle, and Ellis do not explicitly teach "wherein the reader profile information includes one or more types of information selected from

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the group consisting of: behavior profile information" however Headerick does teach voluntary profile information and behavior profile information at col.8, lines 21-27. Thus it would have been obvious to one of ordinarily skilled in the art at the time of the invention to combine the cited references to track demographic information (Headerick: col.8, line 19).

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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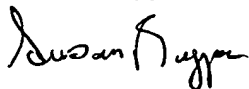
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (703) 305-0311. The examiner can normally be reached M-F: 8am - 4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for Official communications, (703) 746-7238 for After Final communications and (703) 746-7240 for Status inquiries and draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Susan Rayyan



April 26, 2004



GRETA ROBINSON  
PRIMARY EXAMINER